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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
07/728,428	07/11/1991	JO ANN M. CANICH	89B010-D-1	5216

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EXAMINER

RABAGO, ROBERTO

ART UNIT	PAPER NUMBER
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1713

MAIL DATE	DELIVERY MODE
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05/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

07/728,428

Applicant(s)

CANICH, JO ANN M.

Examiner

Roberto Rábago

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): see attachment.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: 27,44-47 and 122.
- Claim(s) objected to: _____.
- Claim(s) rejected: 48-56 and 60-82.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Attachment to Advisory Action

1. The requirement for restriction is maintained. In view of the complex interference history and distinct issues of multiple obviousness-type double patenting rejections, addition of a new invention into this application will cause substantial new examination burden in this application, and would serve to complicate the overall prosecution history. The prosecution history of other applications or patents, and well as issues regarding possible patent term in this or other applications, are not relevant to whether the process claims are required to be rejoined and examined in this application. Applicants are not entitled to simply combine together different inventions from different applications into one application, on the grounds that because the other application is being examined or has already been examined, then no burden exists. If a second invention were to be permitted into this application, applicants would then be free to add new embodiments of the second invention, irrespective of what may have been examined in the other application. Applicants may be entitled to rejoinder of process claims provided they depend from or otherwise include all of the limitations of an allowable product claim; however, as this application contains no such process claims, no claims are eligible for rejoinder at this time.

2. Obviousness-type double patenting (ODP) rejections over 5,621,126 and 6,617,466 are withdrawn in view of argument.

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3. The ODP rejection over US 7,041,841 is maintained. Applicants argue that because a terminal disclaimer (TD) has been filed in the application of the '841 patent, then no further TD is necessary in this application. This argument is not accepted because the ~~coexisting~~ '841 patent would have an earlier expiration date, and therefore if no TD was required in this application, then applicants would obtain an unjustified timewise extension of term in any patent which issues from this application. Regarding the two-way test, applicants appear to be arguing that the instant claims are not obvious over the patented claims because the patented claims do not include the full scope of embodiments specified in the instant claims. However, there is no requirement that each claim set include all of the embodiments of the other claim set. The issue is whether at least one claim of each application/patent includes at least one compound which is anticipated or obvious over at least one claim of the other application/patent. In this case, the instant claims are clearly anticipated by the patented claims because they are broader, and therefore the only question is whether the patented claims are anticipated or obvious over the instant claims. The claims of this application point clearly to the embodiments of the patent claims, and if the instant claims were prior art, they would form the basis of a rejection of the patented claims under 35 USC 102. This is especially apparent in view of the working examples of the instant application which support the claims, wherein Examples A and B explicitly disclose compounds within the scope of the patented claims. MPEP 804 II.B.1. includes the following regarding use of the specification in support of a double patenting rejection:

Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious

variation of an invention claimed in the patent. In re Vogel, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). The court in Vogel recognized "that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim," but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim.

The examples from the instant specification which support the claims cast doubt on whether a two-way test is required for this ODP rejection. It would appear that applicants could have filed, in this application, at least some of the claimed subject matter of the patented claims, because compounds common to both the patented and instant claims have been specifically disclosed in this application. Regardless of whether a one-way or a two-way test is applied, the instant claims are properly rejected under ODP over the '841 patent.

4. The ODP rejection over RE 37,788 is maintained. Applicants argue that the use of R' bound by a 1° or 2° carbon atom provides an unexpected technical effect of improved comonomer incorporation. Review of the patented specification reveals that only Ti complexes have been studied, and therefore even if an unexpected result was shown for Ti complexes, no unexpected result was shown for Zr or Hf species. The instant claims include numerous Zr and Hf species for R' which would readily be envisioned as being bound by a 1° or 2° carbon atom from the description that R' is a C₁₋₂₀ hydrocarbyl. Furthermore, the instant specification has specifically recommended numerous examples of such species at Table 1. The disclosure from the instant specification which supports the claims cast doubts on whether a two-way test is required for this ODP rejection. It would appear that applicants could have filed, in this

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application, at least some of the claimed subject matter of the patented claims, because embodiments common to both the patented and instant claims which have not been shown to provide any unexpected benefit have been clearly disclosed in this application. Regardless of whether a one-way or a two-way test is applied, the instant claims are properly rejected under ODP over RE 37,788.

5. Rejections over Tomotsu and Campbell are withdrawn. Although each of the references has suggested the inclusion of alcohol or glycol compounds which appeared form the required L component, applicants' argument has provided sufficient doubt that these compounds would necessarily form the required dative bond.

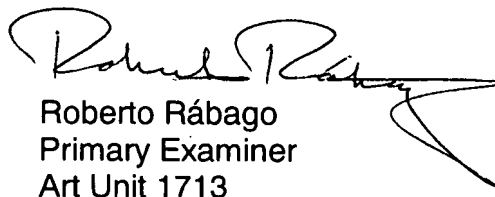
6. Rejections under 35 USC 102(g) over the lost interference count are withdrawn in view of argument.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Roberto Rábago
Primary Examiner
Art Unit 1713

RR
May 15, 2007